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MEMORANDUM

DATE: May 15, 2008
TO: Technology Center Directors
FROM: John J. Love *John J. Love*
Deputy Commissioner for Patent Examination Policy

SUBJECT: Clarification of "Processes" under 35 USC § 101

Last week, the U.S. Patent & Trademark Office presented its views on subject matter eligibility of process claims to the Court of Appeals for the Federal Circuit in *In re Bilski*, Appeal No. 2007-1130. This memo is to ensure that examiners are examining applications consistent with that view. In particular, this clarification is provided to assist examiners in determining, on a case by case basis, whether a method claim qualifies as a patent eligible process under 35 USC § 101. The following discussion is intended to be used in conjunction with the Interim Guidelines when evaluating whether a claimed invention falls within a statutory category of invention. (See MPEP § 2106.IV.B: *Determine Whether the Claimed Invention Falls Within An Enumerated Statutory Category*.)

As explained in the Interim Guidelines, the first step in determining whether a claim recites patent eligible subject matter is to determine whether the claim falls within one of the four statutory categories of invention recited in 35 USC § 101: process, machine, manufacture and composition of matter. The latter three categories define "things" or "products," while a "process" consists of a series of steps or acts to be performed. For purposes of § 101, a "process" has been given a specialized, limited meaning by the courts.

Based on Supreme Court precedent¹ and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.² If neither of these requirements is met by the claim, the method is not a patent eligible process under § 101 and should be rejected as being directed to non-statutory subject matter.

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

matter that is being transformed, for example by identifying the material that is being changed to a different state.

If the claimed method is determined to be a statutory subject matter eligible process, the inquiry proceeds to determine whether the claimed invention falls within a judicial exception (law of nature, natural phenomena, or abstract idea), as explained in detail in the Interim Guidelines. Determining whether the claimed invention is directed to a statutory category of invention is a **separate inquiry** from whether the claimed invention falls within a judicial exception and whether the invention is limited to a specific practical application of a judicial exception. A complete examination of the pending claims should be made so that all potential rejections and objections are raised normally in the first Office action on the merits. Examiners should use the criteria in this memo for the first step in the analysis for statutory subject matter eligibility of process claims under § 101 and refer to the Interim Guidelines (MPEP 2106.IV.C.) for the additional analysis with respect to determining whether a claim is directed to a judicial exception and whether the invention has a practical application.

The state of the law with respect to statutory subject matter eligibility under § 101 is evolving and is presently an issue in several cases under appeal at the Federal Circuit. As the pending cases on appeal are decided, the Interim Guidelines will be revised to reflect any additional guidance the Office receives from the courts. Examiners are encouraged to seek assistance from their managers and pertinent training materials.